



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,238	09/08/2000	John C. Zurawski	073030.0136	3002
7590 03/24/2006				
Baker Botts LLP 2001 Ross Avenue Dallas, TX 75201-2980		EXAMINER ENGLAND, DAVID E		
		ART UNIT PAPER NUMBER 2143		
DATE MAILED: 03/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,238

Applicant(s)

ZURAWSKI, JOHN C.

Examiner

David E. England

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 17 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 – 6 and 11 – 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claims 1 and 11 are not limited to tangible embodiments. In view of Applicant's disclosure, the medium is not limited to tangible embodiments or result nor does the disclosure state what a computer-readable medium could be.
5. Claims 2 – 6 and 12 – 15 are rejected for their dependence on the above mentioned claims.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the function portions must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Art Unit: 2143

7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coile (6654795) in view of Hasegawa et al. (6333752) (hereinafter Hasegawa) in further view of Nguyen et al. (6202070) (hereinafter Nguyen), in further view of Anabuki et al. (6441913) (hereinafter Anabuki).

10. As per claim 1, as closely interpreted by the Examiner, Coile teaches a method, comprising the steps of:

11. providing a set of predetermined function definitions which are different, (e.g. col. 1, lines 37 – 65, “*HTTP, IP*” & col. 4, line 36 – col. 5, line 12, “*IP*”);

12. a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are

Art Unit: 2143

functionally related according to the corresponding function definition, (e.g. col. 1, lines 37 – 65 & col. 4, line 36 – col. 5, line 12, “*source and destination ports*”);

13.

14. binding information which includes binding portions that each associate a respective said input port with one of said output ports, (e.g. col. 1, lines 37 – 65 & col. 4, line 36 – col. 5, line 12, “*IP packet*”); but does not specifically teach image data;

15. at least one of said predetermined function definitions defining a function for manipulating image data;

16. storing a project definition that is operable when executed to process said image data;

17. allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool; and

18. automatically initiating execution of said project definition in response to a change to said image data in said data source;

19. wherein said execution of said project definition operates at least in part to manipulate a graphical aspect of said image data.

20. displaying a project window that includes a graphical representation of said project definition;

21. a further portion which includes a source portion identifying a data source and defining an output port through which data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which data can be supplied to the data destination.

22. Hasegawa teaches image data, (e.g. Abstract);

Art Unit: 2143

23. at least one of said predetermined function definitions defining a function for manipulating image data, (e.g. col. 30, lines 9 – 18, “*The editing and processing section...*”);
24. displaying a project window that includes a graphical representation of said project definition, (e.g., Figures 5 – 9 & col. 33, lines 8 – 35);
25. storing a project definition that is operable when executed to process said image data, (e.g. col. 30, lines 44 – 52);
26. allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool, (e.g. col. 30, lines 52 – 67, “*drag mouse*”); and
27. wherein said execution of said project definition operates at least in part to manipulate a graphical aspect of said image data, (e.g. col. 29, line 64 – col. 30, line 18, “*image changing section*”).
28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hasegawa with Coile because it would allow the user to easily check the characteristics of each image, and quickly grasp situations such as separated shape and size of the image on the contracted image, therefore the user can efficiently retrieve and manipulate any image.
29. Nguyen teaches automatically initiating execution of said project definition in response to a change to data in said data source, (e.g. col. 3, line 38 – col. 4, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a system automated in response to updated information, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Art Unit: 2143

30. Anabuki teaches a further portion which includes a source portion identifying a data source and defining an output port through which data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which data can be supplied to the data destination, (e.g. col. 4, lines 4 – 33, “*input and output*” & Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Anabuki with the combine system of Coile, Hasegawa and Nguyen because utilizing an input and output portion allows the device to obtain image data from outside devices such as a communication network or facsimile machine, manipulate image data to the clients specification and output the newly manipulated image data to another device on the communication network such as a external storage device.

31. As per claim 2, as closely interpreted by the Examiner, Coile and Anabuki do not specifically teach the steps of causing said data source to automatically generate a trigger in response to a change to said image data therein;

32. causing said data source to automatically transmit said trigger through a communications link; and

33. responding to receipt of said trigger through said communications link by effecting said initiating of execution of said project definition. Hasegawa teaches image data and Nguyen teaches the steps of causing said data source to automatically generate a trigger in response to a change to data therein, (e.g. col. 3, line 38 – col. 4, line 20 & col. 26, lines 35 – 65);

34. causing said data source to automatically transmit said trigger through a communications link, (e.g. col. 3, line 38 – col. 4, line 20 & col. 26, lines 35 – 65); and

Art Unit: 2143

35. responding to receipt of said trigger through said communications link by effecting said initiating of execution of said project definition, (e.g. col. 3, line 38 – col. 4, line 20 & col. 26, lines 35 – 65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hasegawa and Nguyen with Coile because of similar reasons as stated above and furthermore, it would make a system more efficient to have a real time system that transmits changes over a network automatically immediately as they happen.

36. As per claim 3, as closely interpreted by the Examiner, Coile and Hasegawa do not specifically teach the step of expressing said trigger in a public communication protocol. Nguyen teaches teach the step of expressing said trigger in a public communication protocol, (e.g. col. 3, line 38 – col. 4, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Nguyen with the combine system of Coile and Hasegawa because of similar reasons as stated above.

37. As per claim 4, as closely interpreted by the Examiner, Coile teaches the step selecting as said public communication protocol the eXtensible Markup Language (XML) protocol, (e.g. col. 1, lines 15 – 30).

38. As per claim 5, as closely interpreted by the Examiner, Coile teaches the step of configuring said communications link to include a network, (e.g. col. 7, line 55 – col. 8, line 24 & col. 8, lines 46 – 65).

Art Unit: 2143

39. As per claim 6, as closely interpreted by the Examiner, Coile, Hasegawa and Anabuki do not specifically teaches the step of configuring said network to include a portion of the Internet. Nguyen more specifically teaches the step of configuring said network to include a portion of the Internet, (e.g. col. 37, lines 1 – 38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Nguyen with the combine system of Coile, Hasegawa and Anabuki because it would be more efficient for a system to be able to adapt and utilize a network that could communicate and interact with user around the world.

40. Claims 7 – 17 are rejected for similar reasons as stated above.

Response to Arguments

41. Applicant's arguments, see Remarks page 9 – 10, filed 12/22/2005, with respect to Drawing Objections for the limitation of "trigger" have been fully considered and are persuasive. The Applicant submits a paragraph starting at page 71, line 30 et seq. stating that the definition of a "trigger" is a request. Therefore, the term "trigger" is now limited to this definition stated on page 71, line 30 to page 72, line 24. The Drawing Objection of "trigger" and "responding to receipt of said trigger through said communications link by effecting said initiating of execution of said project definition" has been withdrawn. Furthermore, Applicant clarifies the limitation with overcomes the rejection under 112.

Art Unit: 2143

42. Applicant's arguments filed 12/22/2005 have been fully considered but they are not persuasive.

43. In the Remarks, Applicant argues in substance that The Board of Patent Appeals and Interferences recently confirmed that methods or processes, such as those recited in independent Claims 1 and 11, are patentable subject matter. "[A]ll that is necessary, in our view, to make a sequence of operational steps a statutory 'process' within 35 U.S.C. § 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of 'useful arts.' Const. Art. 1, sec. 8." *Ex Parte Lundgren*, Appeal No. 2003-2088, 2004 WL 3561262 (Bd. Pat. App. & Interf, April 20, 2004) (citing *In re Musgrave*, 431 F.2d 882, 893, 167 U.S.P.Q. 280, 289 (CCPA 1970)).

44. Thus, Applicant respectfully submits that independent Claims 1 and 11 are directed to statutory subject matter. Because independent Claims 1 and 11 are directed to statutory subject matter, Applicant respectfully requests reconsideration and allowance of Claims 1 and 11 and their respective dependent claims.

45. As to **part 1**, Examiner would like to point out that the law that is cited is for the methods of doing business in which states *Ex parte Lundgren* is a decision by the United States Patent and Trademark Office board of appeals, i.e. the Board of Patent Appeals and Interferences (BPAI), that asserts that process inventions do not have to be in the technological arts in order to be patentable in the United States, i.e. business method claim. They do, however, **have to** produce a "concrete, useful and **tangible result**".

Art Unit: 2143

46. Applicant's claim is **not** a method of doing business. Although the application may be "useful", it is not limited to tangible result. Furthermore, in the revised 101 Interim Guidelines, it states that the technological arts test is not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter, (page 42 of the Interim Guidelines); therefore Attorney's test can not be applied. Therefore, rejection stands.

47. In the Remarks, Applicant argues in substance that the combination of Coile, Hasegawa, Nguyen and Anabuki, whether taken alone or in combination, fail to teach or suggest every element of the claims. More specifically, two limitations of claim 1: "storing a project definition that is operable when executed to process said image data", and "automatically initiating execution of said project definition in response to a change to said image data in said data source".

48. As to **part 2**, the Examiner would like to draw the Applicant's attention to their specification. In which, one can read the Applicant's definition of "project definition"; "a project definition 14 that defines how data from the files in the subdirectory 12 *should be processed*, and two computer subdirectories 16 and 17 that serve as data destinations into which files containing the processed data will be stored," (e.g., page 9). Throughout the rest of the Applicant's specification, are what said "project definitions" actions could be. With such a vague definition to "project definition" it would leave on to interpret in many different lights. Applicant's limitation of "storing a project definition that is operable when executed to process said image data" can be interpreted as a type of program or module that is stored on a computer and is called on when an action, that is not specifically defined in this section, is taken on an image. Taking an

Art Unit: 2143

action such as saving or manipulating an image is not novel and is commonly done in the art whether it is an image, text or any data.

49. Applicant's other augured limitation of, "automatically initiating execution of said project definition in response to a change to said image data in said data source," does not have what the "change" could or would be. All that is stated is that there is a "change" which could be change in location, image type, (gif to jpeg), size, color or any attribute. Now since the main definition of a "project definition" is how data from a file **should be processed**, could make one interpret once an attribute is desired to change, i.e., changing from gif to a jpeg, once it is selected and a Save button is executed that would activate the "project definition" save the data as a new type. There are multiple other examples to give in light of the prior art as stated above and the example herein does not limit what other limitations could be interpreted into the claim language.

50. In the Remarks, Applicant argues in substance that Hasegawa fails to teach or suggest "displaying a project window that includes a graphical representation of [the] project definition," as further required by claim 1. Applicant further states, that while Hasegawa illustrates a graphical interface, this interface merely displays multiple versions of an image to permit a user to view the effect of different combinations of parameters on peripheral images related to a reference image. Applicant states that this is not a graphical representation of a project definition.

51. As to **part 3**, Examiner would like to draw the Applicant's attention to the above interpretation of "project definition" which stems from the Applicant's specification. In light of the definition and the prior art of Hasegawa, the project window, which has multiple images, are

Art Unit: 2143

each modified differently as the result of what the “project definitions” have done the images, (a “project definition” is how data from a file **should be processed**” or has interpreted how the data from the file was processed). Therefore, the “project definition” can be displayed, because it is how the image files are processed.

52. In the Remarks, Applicant argues in substance that the Office Action fails to establish a prima facie case of obviousness because of Office Action relies on two different embodiments of Hasegawa without providing a suggestion or motivation for the combination.

53. As to **part 4**, Examiner would like to draw the Applicant’s attention to the above motivation for it can be found in Hasegawa on column 29 et seq. Furthermore, Applicant’s statement above makes one believe that the Applicant is suggesting that one of ordinary skill in the art would not have the ability to utilize or combine multiple embodiments **within the same invention**. Which would also make one believe that the Applicant believes that one is not responsible for reading the entire reference to understand that all embodiments of **one** patent can be used together.

54. Examiner states that it is within any skill in the art to utilize multiple embodiments, **with in the same patent**, together or separately in forming a tangible and useful product. It would be unrealistic to believe that an Inventor of multiple embodiments **in the same patent** would not have the skill to utilize all or some of the embodiments of the invention together.

55. Furthermore, when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401

Art Unit: 2143

F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA, 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

56. In the Remarks, Applicant argues in substance that Coile, Hasegawa, Nguyen and Anabuki in combination fail to teach or suggest “automatically initiating execution of said project definition in response to a change to said image data in said data source”, more specifically the relied upon reference of Nguyen. Furthermore, Nguyen teaches away from the combination.

57. As to **part 5**, Examiner would like to draw the Applicant’s attention to the response to arguments above in reference to “project definition”, for they are applied herein. Utilizing a broad interpretation to the broad definition to the term “project definition” in light of the specification Nguyen, along with other references, teaches the claim limitation of, “automatically initiating execution of said project definition in response to a change to said image data in said data source”. Examiner would also like to point out to the Applicant that in the Summary of the Invention in Nguyen starting in column 5 et seq., there is teachings of database management in

Art Unit: 2143

which a “process” is executed automatically in response to a “change” to image data, (in Nguyen is interpreted as having disk images for image data). Therefore, because the claim language is silent on what constitutes a “change” or what type of execution of said “project definition” could be doing the prior art in combination teaches the claim language.

Conclusion

58. Applicant is asked to contact the Examiner to clarify any discrepancies and to discuss ambiguities and misinterpretations so to aid in furthering prosecution.

59. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2143

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

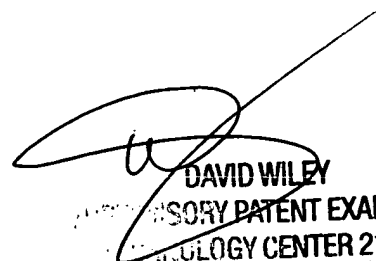
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

DE

DE


DAVID WILEY
ASSISTANT PATENT EXAMINER
ELECTRONIC BUSINESS CENTER 2100